

**Appl. No. 09/856,976**

**Art Unit 1638**

**July 6, 2004**

**Reply to Office Action of February 4, 2004**

**REMARKS**

Applicants thank the Examiner for his time and courtesies extended to Applicants' representation during the Interview of October 15, 2003. Applicants believe that the Interview has advanced prosecution of the present application. Various ways of addressing the outstanding rejections were discussed, and some rejections were also withdrawn.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present reply, claims 1, 2, 4, 5 and 6 have been amended. Also, claim 3 has been canceled without prejudice or disclaimer of the subject matter contained therein, and claim 15 has been added. Claims 8, 10, 11, 12 and 14 were previously canceled. Thus, claims 1-2, 4-7, 9, 13 and 15 are pending in the present application.

No new matter has been added by way of these amendments and new claim because each amendment and new claim is supported by the present specification. For example, each of the amendments to claims 1-2 is supported at pages 5-6 and the various vectors used in the Example (i.e., see page 12, lines 24+) of the present

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specification. The amendments to claims 4-6 are editorial in nature wherein there is support for such amendments throughout the specification. Further, such amendments are not narrowing in scope. By amending these terms in order to clarify the claimed invention, Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents. New claim 15 has support in the present specification at pages 3-6, the various vectors used in the Example (*i.e.*, see the section titled "Transformation" on page 13, starting at line 10) and the original claims. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Summary of the Interview**

In accordance with M.P.E.P. § 713.04, Applicants provide the following remarks.

During the mentioned Interview, Applicants and the Examiner discussed the various outstanding rejections, including the

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rejection under 35 U.S.C. § 112, second paragraph. For instance, Applicants repeated the argument regarding the claim language "recognized", and the Examiner made suggested claim amendments for clarification purposes.

***Issues under 35 U.S.C. § 112, Second Paragraph***

Claims 2-7, 9 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness (as stated in paragraph 6 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

With regard to all claims, Applicants respectfully refer the Examiner to the presented claims. For instance, "recognized" has been replaced with the binding and catalyzing language, wherein Applicants submit such language should be more definite. Claim 3 has been canceled, rendering the rejection of this claim moot. With regard to claim 4, the Examiner's suggestion (made during the Interview) has been adopted. With regard to claim 5, Applicants submit that the claimed vector can replicate in both a "bacterial cell for vector amplification" and an "Agrocaterium host cell", and the expression of claim 5 as presented clearly describes such

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properties. With regard to claim 6, the claim is directed to transforming a plant cell. Accordingly, Applicants respectfully submit that the disputed claims fully comply with the provisions of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this rejection are respectfully requested.

***Issues under 35 U.S.C. § 112, First Paragraph***

Claims 18-24 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description. Applicants respectfully traverse and submit that this rejection is in error since claims 18-24 are not presented. Withdrawal thereof is requested.

If the Examiner is referring to claim 5, Applicants respectfully refer the Examiner to the scope of this claim as presented.

***Issues under 35 U.S.C. § 102(b)***

Claims 1-7, 9 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gartland et al., *Methods in Molecular Biology*, Vol. 44, pages 15-28 (1995) (hereinafter the "Gartland" reference; as stated in paragraph 9 of the Office Action).

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Applicants respectfully traverse and reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action at page 5, the Examiner asserts that the cited Gartland reference discloses a T-DNA border region comprising more than one T-DNA left border sequence, and refers Applicants to page 16, second paragraph, page 17 and Figure 1(B) of this reference. However, Applicants respectfully note that each of the T-DNA left border regions of the vector pRiA4b in Fig. 1(B) in Gartland contain only one left border sequence (and the other border sequence is a T-DNA right border sequence). Thus, Applicants respectfully submit that the Gartland reference fails to disclose all features as instantly claimed (*i.e.*, a vector for the *Agrobacterium*-mediated plant transformation comprising a T-DNA left border region comprising more than or at least two T-DNA left border sequences).

Accordingly, Applicants respectfully submit that because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Gartland reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053

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(Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Gartland has been overcome. Reconsideration and withdrawal are respectfully requested.

### **Conclusion**

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to July 4, 2004, in which to file a reply to the Office Action. The required fee of \$420.00 is enclosed herewith.

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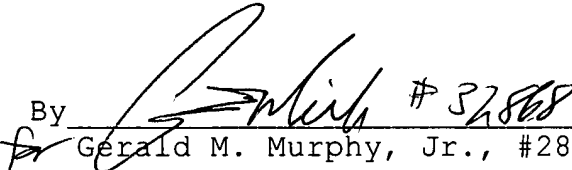
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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